UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,793	04/20/2004	Edwin C. Iliff	ILIFF.015A6D1	5083

20995 7590 06/21/2007

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER	
ZHOU, SHUBO	

ART UNIT	PAPER NUMBER
1631	

NOTIFICATION DATE	DELIVERY MODE
06/21/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
eOAPilot@kmob.com

Office Action Summary	Application No.	Applicant(s)	
	10/828,793	ILIFF, EDWIN C.	
	Examiner	Art Unit	
	Shubo (Joe) Zhou	1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 March 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *6-34* is/are pending in the application.

4a) Of the above claim(s) *9,15 and 22-34* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6-8,10-14 and 16-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *See Continuation Sheet*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :8/23/04,6/6/05,10/19/05,11/10/05,4/21/06,3/29/07,5/18/07.

DETAILED ACTION

Election/Amendments

Applicants' election, with traverse, of Group II(claims 5-8) in the response filed 10/24/06 were previously acknowledged and the requirement made final in the Office action mailed 1/22/07.

The amendment to the claims filed 10/24/06 necessitated the species election requirement made in the Office action mailed 1/22/07. Applicants' election of species B and D in the response filed 3/22/07 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the species election requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Accordingly, claims 6-34 are currently pending, and claims 6-8, 10-14, and 16-21 are under examination.

Claims 9, 15 and 22-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions or species, there being no allowable generic or linking claim. Applicant timely traversed the group restriction (election) requirement in the reply filed on 10/24/06. Election of species was made **without** traverse in the reply filed on 3/22/07.

Information Disclosure Statement

The Information Disclosure Statements filed 8/23/04, 6/6/05, 10/19/05, 11/10/05, 4/21/06, 3/29/07 and 5/18/07, respectively, have been entered and the information references

therein have been considered. Initialed copies of the form PTO-1449 are enclosed with this action.

Specification

The specification is objected to because of the following including informalities:

Trademarks are used in this application, such as VXWORKS™ on page 89. All trademarks should be capitalized wherever they appear and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort should be made to prevent their use in any manner that might adversely affect their validity as trademarks.

Appropriate correction is required.

Claim Rejections-35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 6-8, 10-14, and 16-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are drawn to a system comprising various objects. The specification on page 11 states:

> *In computer software terms, an object is combination of data and processes that manipulate the data. The data are said to be "encapsulated," meaning that they are hidden, so that a user of the object only sees processes that can be invoked. Using an*

object's processes, one can then manipulate the data without having to know the exact location and format of the data. When more than one copy of the object is required, one can make copies of the data, but use the same process set to manipulate each of the copies as needed. This set of processes can then be thought of as an "engine" that controls or represents the objects' behavior, whether there are 10 or 10,000 object copies.

Consequently, the claimed system with multiple objects is reasonably interpreted as a combination of data and processes that manipulate the data. Thus, the claimed invention appears to have product and process in the same claims.

MPEP 2173.05(p) states:

II. PRODUCT AND PROCESS IN THE SAME CLAIM

A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In Ex parte Lyell, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph.

Such claims should also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. Id. at 1551.

Therefore, the instant claims are rejected because they are neither a process nor a product, but appear to embrace or overlap two different statutory categories of invention.

Claim Rejections-35 USC § 112

The following is a quotation of the **second** paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-8, 10-14, and 16-21 are rejected under 35 U.S.C. 112 , second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The court held that a single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In Ex parte Lyell, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph.

As set forth above, the instant claims are neither a process nor a product, but appear to embrace or overlap two different statutory categories of invention. Thus, the claims are ambiguous as to what are claimed.

Clarification of the metes and bounds of the claims is requested.

Claim Rejections-35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 6-8, 10-14, and 16-21 are rejected under 35 U.S.C. § 102(e) as being anticipated by Iliff, E. C. (IDS document: US 5,935,060, Aug. 10, 1999).

The claims are drawn to a system comprising various objects selected from disease object, symptom object, valuator object, question object, node object, and candidate object.

Iliff discloses a medical diagnosis computer system comprising various data and scripts and software for using the system and the data for diagnosis. See at least the Abstract. The combination of data and scripts for manipulating the data is interpreted as reading on the "object" recited in the instant claims.

With regard to claims 6-7, the system of Iliff comprises at least a plurality of disease objects and a plurality of symptom objects. See at least Fig. 3B and Fig. 10, and columns 1-3.

With regard to claim 8, the system of Iliff comprises a "diagnostic script engine," which is interpreted to be the engine object recited in the claim. See at least Fig. 1B, and columns 1-3.

With regard to claim 10, the objects in the system of Iliff are arranged in a hierarchical relationship so that the result of one is the input of another. See at least Fig. 2, and columns 1-3.

With regard to claim 11, the system of Iliff comprises, in addition to the disease and symptom objects as in claims 6-7 above, also comprises question object, node object, valuator object and candidate objects. See at least Figures 7-15, and columns 1-3.

With regard to claims 12-14, and 18, the system of Iliff comprises symptom, valuator and node objects, where symptom object invokes valuator object, which in turn invokes the question object, which then invokes the node object. See at least Fig. 4b and columns 1-3.

With regard to claims 16 and 17, Iliff discloses that a particular disease is associated with geographic information and diseases in a population and the frequencies therein. The system also comprises data and scripts for a plurality different diseases sharing common symptoms, such as "fever" shared by appendicitis, intestinal flu, food poisoning, and malaria. See at least column 8.

With regard to claims 19, in the system of Iliff, the script engine will execute an individual script which is linked to specific data. Thus, each object is only to see the script of another object, not the data.

With regard to claim 20, Fig. 3B of Iliff shows that one disease object, e.g. disease object A, asks questions, and depending on the answers, the diagnostic process could stay on object A or goes to disease object B, which in turn asks questions, and again, depending on answers, it could to the next disease object, until finally, it may go to the last disease object X. Thus, disease object X is an object that monitors the questions and answers of the other disease objects.

With regard to claim 21, the system of Iliff comprises a script engine that coordinates all the entire process of diagnosis because it controls all the scripts. See at least columns 18-19.

Provisional Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The

filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 6-8, 10-14, and 16-21 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 6-10 and 20-42 of US copending Application No. 09/785,044. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. Claims 1-8 are identical in scope compared to claims 1-8 of copending Application No. 10/955,900, respectively.

Claims 6-8, 10-14, and 16-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6-8, 20-30 and 49-50 of US copending Application No. 09/785,044.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shubo (Joe) Zhou, whose telephone number is 571-272-0724. The examiner can normally be reached Monday-Friday from 8 A.M. to 4 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, Ph.D., can be reached on 571-272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of

document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

sz/SZ

SHUBO (JOE) ZHOU, PH.D.
PATENT EXAMINER